



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09 675,912	09/29/2000	John H. Kickhafer	6499-4	8982

7590 01/16/2003

Walter W Duft
Law Offices of Walter W Duft
10255 Main Street
Suite 10
Clarence, NY 14031

EXAMINER

FUREMAN, JARED

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 01/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/675,912

Applicant(s)

KIEKHAEFER, JOHN H.

Examiner

Jared J. Fureman

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 21 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-11, 15-26 and 30-90 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-11, 15-26, 30-57, 70-79 and 82-84 is/are rejected.
- 7) ☐ Claim(s) 58-69, 80, 81 and 85-90 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 29 September 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Receipt is acknowledged of the response and IDS filed on 10/21/2002, which have been entered in the file. Some references have been lined through on the IDS, since the references were already cited on a previous IDS or a PTO-892. Claims 1-11, 15-26, and 30-90 are pending.

1. The indicated allowability of claims 1-11, 15-26 and 30-57, 70-79 and 82-84 is withdrawn in view of the newly discovered reference(s) to Lasch et al (US 2002/0130186 A1). Rejections based on the newly cited reference(s) follow.

Specification

2. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Terminal Disclaimer

3. The terminal disclaimer filed on 10/21/2002 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Pat. Numbers 6,290,137 and 6,296,188 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Objections

4. Claim 75 is objected to because of the following informalities: Claim 75, line 2: "one" should be replaced with --on--. Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-11, 15-26, 30-39, 42, 43, 45-57, 70-79 and 82-84 are rejected under 35 U.S.C. 102(e) as being anticipated by Lasch et al (US 2002/0130186 A1).

Lasch et al teaches a financial transaction card (5) and a method for manufacturing a financial transaction card that is transparent or translucent to human viewing yet detectable by automated card processing equipment (not shown) having near infrared source/detector pairs each having a source and a detector respectively positioned to face opposing sides of the card when the card is positioned in the equipment for detection and to detect the card by sensing an interruption of near infrared light transmitted from the source to the detector due to the presence of the card, comprising: a substantially planar material sheet (front sheet 10 and/or back sheet 12) having upper and lower surfaces bounded by a continuous peripheral edge, the material sheet being transparent or translucent to human viewing, a near infrared light filter (an optically recognizable compound) covering one of the upper or lower surfaced of the material sheet, the filter comprising a light absorbing dye filtering means for providing sufficient card opacity relative to one or more near infrared light wavelengths

to render the card detectable by the source/detector pairs by blocking near infrared light emitted by the source from reaching the detector, thereby triggering detection of the card, while still allowing the card to remain transparent or translucent to visible light, wherein the card transmits human visible light with at least about 15% transmittance (since the card 25 is defined as transparent or translucent, the card 25 necessarily transmits human visible light with at least about 15% transmittance), wherein the automated card processing equipment includes card embossing/encoding machines having source/detector pairs operating in a light wavelength range of about 750-1200 nm, and wherein the filter has an opacity relative to one or more specific wavelengths within the range of not substantially less than about 1.0, wherein the one or more specific wavelengths include about 890 nm, 920 nm and about 950 nm, wherein the filter further comprises a light scattering material (a refracting, diffusing and/or reflecting material), wherein the filter is formed as a filter coating (an ink, for example) applied to the material sheet, wherein the filter is a clear, light absorbing material providing the requisite light filtering properties, wherein the filter is formed from a light filtering material disbursed through all or a portion of the material sheet, wherein the filtering means applied to the material sheet as a liquid coating (an ink, for example), wherein the liquid coating is applied to the material sheet by screen printing, wherein the screen printing is performed using a screen mesh size of between about 90-390 mesh (Lasch et al teaches a mesh size of 80 lines/cm, which is about 90), wherein the filter is made from a light absorbing dye material dissolved in a liquid coating material at a dye-to-coating weight ratio of up to about .25-25%, wherein the liquid coating comprises a plastic resin-

based coating material (a thermoset resin), wherein a colorant is added to the filter to provide a desired color or tint, wherein the filter includes a fluorescent material (the optically recognizable components may contain other detectable compounds, such as, for example, UV-fluorescent or IR-fluorescent features), printed graphics (text 30, 32, 33, 34 and logo 50) formed over non-opposing second surfaces of the material sheets (front 10 and back 12 sheets), clear protective overlay sheets (lamination sheets) formed over the printed graphics, wherein there is a light filtering coating formed on each of the first surfaces (the IR ink is printed across any portion of the entire card surface), wherein there is a light filtering coating formed on each of the second surfaces (the IR ink is printed across any portion of the entire card surface) (see figures 1-3, paragraphs 2, 11-15, 17, 36-39, 42-44, 53-54, 65-70, 85-88, 90, 92-95, and 113).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 40, 41 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lasch et al.

The teachings of Lasch et al have been discussed above.

Re claims 40 and 41: Lasch et al fails to specifically teach the screen printing being performed using a screen mesh size of about 195 mesh or 305 mesh.

However, Official Notice is taken that it was well known to those of ordinary skill in the art at the time of the invention that the size of the screen being used in a screen printing operation depends upon the desired material to be printed.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to integrate, with the card and method as taught by Lasch et al, the screen printing being performed using a screen mesh size of about 195 or 305 mesh, in order to print the desired material on the card. Furthermore, it is an obvious variation in the screen mesh size, well within the ordinary skill, that fails to produce any unexpected results.

Re claim 44: Lasch et al fails to specifically teach wherein the dye is a dye material that produces a yellow tint and wherein the colorant is a violet colorant material that combines with the yellow tint of the dye material to provide a neutral gray tint in the card.

However, Lasch et al teaches that optically recognizable compounds may be colored to produce a desired effect and that other materials may be added to allow for color shifts (see paragraphs 37 and 44, for example). Thus, any specific colors or effects can be used to provide a desired effect on the card, without providing any unexpected results.

Therefore, in view of Lasch et al's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the card as taught by Lasch et al, wherein the dye is a dye material that produces a yellow tint and wherein the colorant is a violet colorant material that combines with the yellow tint of the dye

material to provide a neutral gray tint in the card, in order to provide the desired effect on the card. Furthermore, it is an obvious variation in the color of the card, well within the ordinary skill, that fails to produce any unexpected results.

Allowable Subject Matter

9. Claims 58-69, 80, 81 and 85-90 are objected to as being dependent upon rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. The following is an examiner's statement of reasons for allowance and the indication of allowable subject matter: The prior art of record, taken alone or in combination, fails to teach or fairly suggest: a financial transaction card wherein a coating is made having the elements recited in claims 58 and 87-90; wherein the light filtering coating on one or both of the first surfaces is a light absorbing coating and the light filtering coating on one or both of the second surfaces is a light scattering coating, in combination with the other claimed limitations as set forth in the claims.

While the elements of claims 58 and 87-90 were well known to those of ordinary skill in the art at the time of the invention (see pages 12 through 25 of the specification), without the benefit of applicant's teachings there is no motivation to combine this specified compound with the other claimed elements so as to produce the financial transaction card as claimed.

While Lasch et al teaches that the light filtering coating (the optically recognizable compounds) may contain light absorbing materials or light scattering coatings (see paragraph 37, for example) and Lasch et al teaches that the light filtering coating may

be printed across any portion of the entire card surface (see paragraph 38, for example), Lasch et al fails to specifically teach the light filtering coating on one or both of the first surfaces is a light absorbing coating and the light filtering coating on one or both of the second surfaces is a light scattering coating. Without the benefit of applicant's teachings, there is no motivation for one of ordinary skill in the art at the time of the invention to modify the card as taught by Lasch et al to produce the claimed invention.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Response to Arguments

11. Applicant's arguments with respect to claims 1-11, 15-26, 30-57, 70-79 and 82-84 have been considered but are moot in view of the new ground(s) of rejection.

As discussed above, Lasch et al teaches a financial transaction card and method of manufacturing a financial transaction card that is transparent or translucent to human viewing yet detectable by automated card processing equipment.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lasch et al (US 2002/0145049 A1) and Cocco (US 2002/0066790 A1) both teach financial transaction cards and methods of manufacturing financial transaction cards that are transparent or translucent to human viewing yet


detectable by automated card processing equipment, by including an infrared light filtering/blocking layer.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jared J. Fureman whose telephone number is (703) 305-0424. The examiner can normally be reached on 7:00 am - 4:30 PM M-T, and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

jjf
jjf
January 13, 2003


MICHAEL G. LEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800